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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF : APPEAL NO.: 2008-1232
MARI SAITO, et al. : EXAMINER: ABEL-JALIL, N.
SERIAL NO: 09/785,204 :
FILED: FEBRUARY 20, 2001 : GROUP ART UNIT: 2175
FOR: INFORMATION PROCESSING :
APPARATUS AND METHOD
AND PROGRAM STORAGE
MEDIUM

RESPONSE TO ORDER MAILED APRIL 14, 2008

BOARD OF PATENT APPEALS AND INTERFERENCES
United States Patent and Trademark Office
P.O. BOX 1450
Alexandria, Virginia 22313-1450

SIR:

This is a response to the order mailed April 14, 2008 that misinterprets 37 CFR § 41.37(c)(1)(v)(2005).I as requiring the functional recitations of a means-plus-function claim to be mapped to reference characters in the drawing figures, particularly when no Figure illustrates these functions.

As noted in the order, the language of 37 CFR § 41.37(c)(1)(v)(2005).I says nothing about an absolute requirement to map all elements recited by a claim to the reference characters in the drawings. Instead, this section makes it clear that the concise explanation of the subject matter defined in each of the independent claims involved in the appeal needs to refer to reference characters to refer to existing drawings, "if any." Similarly, while every means plus function and step plus function as permitted by 35 U.S.C. §112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as

corresponding to each claimed function must be set forth with reference to the specification, the requirement to use reference characters only applies to the drawings, “*if any*” (emphasis added). Clearly, nothing in 37 CFR § 41.37(c)(1)(v)(2005).I requires the mapping of claim elements to the drawings using reference characters when no such drawings and no such reference characters are presented by the application.

Accordingly, the order clearly exceeds any implied authority in 37 CFR § 41.37(c)(1)(v)(2005).I by improperly requiring a mapping of “associated information,” “existing information corresponding to a past event,” and “existing information having similarity to information corresponding to the present event” that are part of the functional recitations of Claim 1 that are not illustrated in a drawing and not assigned any reference character to be mapped.

In any event, in order to comply with the order as best as it can be complied with, Applicants present the following:

SUBSTITUTE SUMMARY OF THE CLAIMED SUBJECT MATTER¹

The claimed subject matter includes an information processing apparatus and method for displaying associated information that corresponds to a present event. This apparatus

¹It is Appellants’ understanding that, under the rules of Practice before the Board of Patent Appeals and Interferences, 37 CFR §41.37(c) requires that a concise explanation of the subject matter recited in each independent claim be provided with reference to the specification by page and line numbers and to the drawings by reference characters. However, Appellants’ compliance with such requirements anywhere in this document should in no way be interpreted as limiting the scope of the invention recited in all pending claims, but simply as non-limiting examples thereof. Further, this concise explanation of the subject matter recited in each independent claim in no way serves as the actual disclosure of the specification and in no way relieves the burden placed on the U.S. PTO by the decision of *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997).

includes, for example, the acquisition means, event occurrence detection means, search means and display control means recited by independent Claim 1.

In this regard, the acquisition means finds support in the accumulation block 1, shown in Fig. 1, where the accumulation block 1 is disclosed to be a block of an agent program being run on a desk top computer with regard to the exemplary embodiment of Fig. 1 as noted at page 11, lines 2-10, of the specification, for example. The accumulation block 1 is disclosed to be for acquiring associated information not shown in the drawing that includes document keywords that are also not shown in the drawings, via blocks 2-4 and prepares a document feature “past event” database (“events” are defined at page 14, lines 22-24, for example, but are not shown in the drawings) via block 5 as described relative to the steps S1-S7 of FIG. 3 at page 18, line 3-page 21, line 2.

In the exemplary Fig. 1 embodiment supporting independent Claim 1, the “event” occurrence detection means detecting the occurrence of the “present event” finds support regarding the “event” extraction block 8. This event extraction block 8 is described in the specification at page 14, lines 17-24, for example, as detecting the end of e-mail transfer or of a selected text data quantity being exceeded during document editing as “event” occurrences as noted above as to the definition at page 14, lines 22-24.

Moreover the detecting by the event occurrence detection means is described to be detecting the occurrence of a presently occurring “event” at lines 22-24 of page 14 and lines 1-2 of page 15 of the specification, for example. After the detection of this presently occurring event via exemplary block 8 (acting as exemplary “event” occurrence detection means), a search is made of existing information that exists in the document feature or “past

event” database created by the document feature data base preparation block 5. The “similarity” is based on the keyword similarity where keywords correspond to document keywords noted above as to acquiring associated information and attribute information noted at page 15, lines 5-10. Just as the claimed “associated information” and the claimed “existing information corresponding to a past event” are not shown in the drawings, the “existing information having similarity to information” is not shown in the drawings.

Exemplary support for the Claim 1 search means appears relative to the exemplary database inquiry block 9 functioning as the search means in order to find a document with key word and attribute features having a similarity to the information corresponding to the detected present event document as fully explained relative to the exemplary Figure 1 embodiment described at page 15, lines 2-17 of the specification. Support for this search means is also found at page 19, line 18-page 20, line 7 of the specification describing a similar search of URL and title information on the web by information retrieval block 6 functioning as further explained at lines 15-17 of this specification page, the associated information that corresponds to the search results obtained by exemplary database inquiry block 9 search means are supplied to an associated information presentation block 10.

The claimed display control means finds support in this associated information presentation block 10 that provides a display of the associated information that is related to the existing information retrieved by the search means and that is described in the specification at page 15, lines 18-21, for example.

Independent apparatus Claim 9 subject matter includes processing detection means, key word detection means, search means, input means, command processing means, and display control means.

Page 14, lines 17-24 and the above noted agent program blocks of exemplary FIG. 1 also provides support for the independent Claim 9 processing detection means associated with the block 8 detection of mailer program (end of transfer) or word processor program (text data quantity) processing as an event.

The keyword detection means of independent Claim 9 finds exemplary support as to data base inquiry block 9 of exemplary Fig. 1 that captures a document corresponding to the detected event and determines a key word from this event document as described at page 15 lines 1-8.

The database inquiry block 9 of exemplary Fig. 1 that then searches the database for the key words as described at page 15, lines 8-17, of the specification and provides exemplary support for the independent Claim 9 search means. Also note steps S12-S15 of FIG. 5 and the description thereof at page 21, line 15-page 22, line 20, of the specification.

As further explained at page 24, lines 2-16, for example, input means (“see” button) are provided. This input means can take other forms, note, for example, page 31, line 6-page 32, line 11, describing an animated display with an input window 61.

These input means are used to control “command processing means” to execute processing on the associated information retrieved by the search means as to step S18 of FIG. 5 or step S42 of the FIG. 7 agent embodiment that corresponds thereto as explained, for example, at page 32, line 20-page 33, line 6.

With final regard to the FIG. 7 agent embodiment, display control means are provided to first bring the agent onto the display at Step S31 when the associated program is started (see page 28, lines 13-17, for example), and the manner of displaying agent changes in response to the commands inputted by the input means commands of step S41 (see page 34, lines 6-17, for example).

With further regard to an exemplary disclosure of corresponding steps of independent Claim 7, this claim recites a step of extracting attribute information from an existing text file that has support as noted above as to exemplary step S2 of FIG. 3 explained at page 18, lines 10-18 of the specification.

The Claim 7 step of selecting an important word from among words contained in said existing text file finds exemplary support at least as to step S3 of exemplary FIG. 3 explained at page 18, lines 19-23 of the specification.

The Claim 7 step of acquiring said associated information related to said important word selected in the selecting step finds exemplary support in step S6 of exemplary FIG. 3 explained at page 19, line 18-23, of the specification.

The Claim 7 step of constructing a database by use of at least one of said attribute information extracted in the extraction step and said associated information acquired in the acquiring step finds exemplary support at least as to step 7 of exemplary FIG. 3 explained at page 20, lines 8-17, of the specification.

The Claim 7 step of detecting the occurrence of said event finds exemplary support at least as to step S12 of exemplary FIG. 5 explained at page 21, lines 17-24, of the specification.

The Claim 7 step of detecting a key word from said text file corresponding to said event detected in the event occurrence detecting step finds exemplary support at least as to step S14 of exemplary FIG. 5 explained at page 22, lines 7-9, of the specification.

The Claim 7 step of searching said database constructed in the database constructing step for said associated information corresponding to said key word detected in the key word detecting step finds exemplary support at least as to step S15 of exemplary FIG. 5 explained at page 22, lines 10-20, of the specification.

The Claim 7 step of controlling displaying of said associated information retrieved in the searching step finds exemplary support at least as to step S16 of exemplary FIG. 5 explained at page 24, lines 3-8, of the specification.

The exemplary support for the program storage medium of independent Claim 8 is similar as to the flow charts of Figure 3 and Figure 5. In this regard, the computer-readable program for detecting a key word from a text file corresponding to an event that has taken place and displaying associated information related to said key word, includes steps that are the same as recited by Claim 7. Accordingly, the Claim 8 step of extracting attribute information from an existing text file that has support as noted above as to exemplary step S2 of FIG. 3 explained at page 18, lines 10-18 of the specification.

The Claim 8 step of selecting an important word from among words contained in said existing text file finds exemplary support at least as to step S3 of exemplary FIG. 3 explained at page 18, lines 19-23 of the specification.

The Claim 8 step of acquiring said associated information related to said important word selected in the selecting step finds exemplary support in step S6 of exemplary FIG. 3 explained at page 19, line 18-23, of the specification.

The Claim 8 step of constructing a database by use of at least one of said attribute information extracted in the extraction step and said associated information acquired in the acquiring step finds exemplary support at least as to step 7 of exemplary FIG. 3 explained at page 20, lines 8-17, of the specification.

The Claim 8 step of detecting the occurrence of said event finds exemplary support at least as to step S12 of exemplary FIG. 5 explained at page 21, lines 17-24, of the specification.

The Claim 8 step of detecting a key word from said text file corresponding to said event detected in the event occurrence detecting step finds exemplary support at least as to step S14 of exemplary FIG. 5 explained at page 22, lines 7-9, of the specification.

The Claim 8 step of searching said database constructed in the database constructing step for said associated information corresponding to said key word detected in the key word detecting step finds exemplary support at least as to step S15 of exemplary FIG. 5 explained at page 22, lines 10-20, of the specification.

The Claim 8 step of controlling displaying of said associated information retrieved in the searching step finds exemplary support at least as to step S16 of exemplary FIG. 5 explained at page 24, lines 3-8, of the specification.

With further regard to an exemplary disclosure of corresponding steps of independent Claim 15, this claim recites a step of detecting, as an event, predetermined processing of said

predetermined application program that finds exemplary support at least as to step S35 of exemplary FIG. 7 explained at page 30, lines 6-9, of the specification.

The Claim 15 step of detecting a key word from said text file processed by said predetermined application program corresponding to said event detected in the processing detecting step finds exemplary support at least as to step S14 of exemplary FIG. 5 explained at page 22, lines 7-9, of the specification that is incorporated at page 30, lines 13-16 as to FIG. 7.

The Claim 15 step of searching for said associated information by searching for a previously processed existing file corresponding to said key word detected in the key word detecting step finds exemplary support at least as to step S15 of exemplary FIG. 5 explained at page 22, lines 10-20, of the specification that is incorporated at page 30, lines 13-16 as to FIG. 7.

The Claim 15 step of inputting a command finds exemplary support at least as to step S41 of exemplary FIG. 7 explained at page 32, lines 15-19, of the specification as corresponding to step S 17 of FIG.5 that is explained at page 24, lines 12-16, of the specification.

The Claim 15 step of executing, in response to said command inputted in the inputting step, processing on said associated information retrieved in the searching step finds exemplary support at least as to step S42 explained at page 32, line 20-25, of the specification as corresponding to step S18 of exemplary FIG. 5 that is explained at page 24, lines 17-20, of the specification.

The Claim 15 step of displaying, in response to said event detected in the processing of said detecting step, said character onto said display device and changing a manner of displaying said character in response to said command inputted finds exemplary support at least as to step S43 explained at page 33, line 23-page 34, line 3, of the specification as corresponding to step S21 of exemplary FIG. 5 that is explained at page 24, lines 17-20, of the specification.

The exemplary support for the program storage medium of independent Claim 16 is similar as to the flow charts of Figure 5 and Figure 7. In this regard, the Claim 16 computer-readable program step of detecting, as an event, predetermined processing of said predetermined application program finds exemplary support at least as to step S35 of exemplary FIG. 7 explained at page 30, lines 6-9, of the specification just as the corresponding step of Claim 15 does.

The Claim 16 computer-readable program step of detecting a key word from said text file processed by said predetermined application program corresponding to said event detected in the processing detecting step finds exemplary support at least as to step S14 of exemplary FIG. 5 explained at page 22, lines 7-9, of the specification that is incorporated at page 30, lines 13-16 as to FIG. 7.

The Claim 16 computer-readable program step of searching for said associated information by searching for a previously processed existing file corresponding to said key word detected in the key word detecting step finds exemplary support at least as to step S15 of exemplary FIG. 5 explained at page 22, lines 10-20, of the specification that is incorporated at page 30, lines 13-16 as to FIG. 7.

The Claim 16 computer-readable program step of executing, in response to a command inputted, processing on said associated information retrieved in the searching step finds exemplary support at least as to step S42 explained at page 32, line 20-25, of the specification as corresponding to step S18 of exemplary FIG. 5 that is explained at page 24, lines 17-20, of the specification.

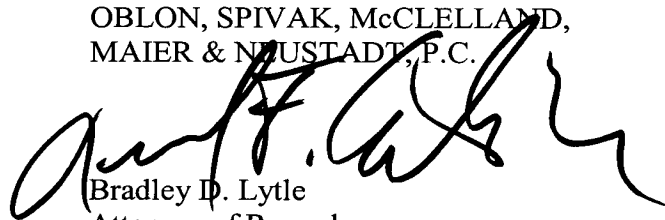
The Claim 16 computer-readable program step of displaying, in response to said event detected in the processing of said detecting step, said character onto said display device and changing a manner of displaying said character in response to said command inputted finds exemplary support at least as to step S43 explained at page 33, line 23-page 34, line 3, of the specification as corresponding to step S21 of exemplary FIG. 5 that is explained at page 24, lines 17-20, of the specification.

Appeal No. 2008-1232
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As this Substitute Summary of the Claimed Subject Matter clearly complies with the order as far as it is possible to comply therewith, prompt consideration of the second supplemental brief in light of this Substitute Summary of the Claimed Subject Matter is respectfully requested.

Respectfully Submitted,

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A handwritten signature in black ink, appearing to read 'Bradley D. Lytle', is written over the printed name and firm name.

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